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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,537	01/27/2004	Tolo M. Rimsky	036359-0101	1643
27433 7590 10/06/2008 FOLEY & LARDNER LLP 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60610-4764				
EXAMINER MANSFIELD, THOMAS L				
ART UNIT 3624		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,537

Applicant(s)

RIMSKY, TOLO M.

Examiner

THOMAS MANSFIELD

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This non-final Office action is in reply to the Application filed on 27 January 2004.
2. Claims 1-77 are currently pending and have been examined.

Claim Objections

3. Claims 20, 21, and 75-77 are objected to because of the following informalities: the recitation of (*graphical*) and (*tabular*) in the claims are objected to because they include limitations which are enclosed within parentheses. Please note that parentheses in a claim are only used for reference characters (see MPEP § 608.01(m)). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 1, 22, 35, 47, and 63 recite the limitation "...*the job selected*". There is insufficient antecedent basis for this limitation in the claims. Claims 1, 22, 35, 47, and 63 recite "*selecting a market...*". For examination purposes the Examiner will interpret "...*job selected*" as "...*market selected*". Appropriate clarification is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 1-77 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-77 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al. (Beck) (U.S. 6,587,832) in view of D'Alessandro (U.S. Pub. No. 2003/0061141).

With regard to Claims 1, 3, 22-25, 35, 37, 38, 47, 48, 50, and 63-65, Beck teaches a *computer networked compensation survey method* (method and system, estimating suitable market-based compensation, surveys) (see at least the Abstract and column 1, lines 45-65 and column 2, lines 23-32) *comprising*:

- *selecting a market* (labor market, job families) *against which to be compared* (market values can then be compared to the internal salaries of employees) (see at least column 1, lines 45-65).
- *selecting an employment category* (position or job as a combination of category) *to be researched* (levels of responsibility) (see at least column 1, lines 54-65 and column 2, lines 33-46).
- *providing market data for the market selected* (salary observations, rank of a position or job, "data point") (see at least column 2, lines 40-46).
- *displaying the market data* (displayed for the specified employee or group) (see at least column 13, lines 10-18 and Fig.'s 5A-5B).
- *allowing a user to perform interpolation or extrapolation based on at least one employment category* (an estimate for that market rate may be obtained by interpolation) (see at least column 6, lines 11-21).
- *providing recommendations about merit increases* (to compute and recommend appropriate salary increases) (see at least column 13, lines 26-40).
- *enabling the user to view market data graphically* (the screen displays the estimated market rates for the 10%ile, 25%ile,...) (see at least column 13, lines 53-60 and Fig's. 4 and 5).
- *simultaneously displaying more than one set of data* (displayed for the specified employee or group) (see at least column 13, lines 10-18 and Fig.'s 5A-5B).

Beck does not specifically teach *enabling the user to project to a future date*. D'Alessandro teaches *enabling the user to project to a future date* (Baldrige Assessment) in analogous art of business performance for the purposes of, "allows management the ability to recognize the linkage between performance of key processes to quality improvement outcomes (including the future allocation of resources to achieve such outcomes" (see at least paragraphs 0046-0049).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the business performance method as taught by D'Alessandro with the market-based compensation method of Beck. One of ordinary skill in the art would have been motivated to do so for the benefit of comparing or benchmarking organizations within and among industries, and to also support longitudinal performance studies (D'Alessandro, paragraphs 0048-0050).

With regard to Claims 2, 26, 36, 49, and 66, Beck teaches *wherein performing interpolation/extrapolation (interpolation) involves selecting from the group consisting of sales, number of employees, evaluation points (job rank), and combinations thereof* (estimated for a particular combination (i,j)) (see at least column 6, lines 11-21).

With regard to Claims 4, 27, 39, 51, and 67, Beck teaches *wherein the market is selected from the group (job family master list) consisting of services, manufacturing (Manufacturing), pharmaceutical (Pharmaceutical), free zone, commercial, insurance, banking (Finance), and others that may appear*, (see at least column 8, line 30 through column 12, line 59) *including classification of industries (industry) by geographical locations (geography), and combinations thereof* (any combination) (see at least 14, line 10-49).

With regard to Claims 5, 28, 40, 52, and 68, Beck teaches *wherein the market to be compared comprises a select group of companies with which to be compared* (see at least 14, line 10-49).

With regard to Claims 6, 29, 41, 53, and 69, Beck teaches *wherein the market to be compared is capable of being further narrowed to the group consisting of sales range, number of employees, evaluation points, and combinations thereof* (method for breaking down a set of observations (market rates) into job families, categories, and levels of responsibility) (see at least column 13, lines 61-66).

With regard to Claims 7, 30, 42, and 54, Beck teaches *wherein the market to be compared is capable of being further narrowed to evaluation points* (evaluation criteria, "median observations" or "data points") (see at least see at least column 8, lines 2-29 and column 15, lines 1-6).

With regard to Claim 8, Beck teaches *wherein the evaluation points are selected from the group consisting of education* (terms of knowledge, education), *experience* (experience), *responsibility for operations, responsibility for company assets, responsibility for supervision* (levels of responsibility), *working conditions, and combinations thereof* (see at least column 8, lines 2-29).

With regard to Claims 9, 31, 43, 55, and 70, Beck teaches *wherein the employment category is selected from a minimum and a maximum number of sales* (profit and loss responsibility) *and the comparison is limited to the companies that are within those parameters* (management category and executive category) (see at least column 8, lines 2-29).

With regard to Claims 10, 32, 44, 56, and 71, Beck teaches *wherein the employment category is selected from a minimum and a maximum number of employees* (size of company) *and the comparison is limited to the companies that are within those parameters* (see at least column 14, lines 46-49).

With regard to Claims 11, 33, 45, 57, and 72, Beck teaches *wherein the employment category is selected from a minimum and a maximum number of evaluation points (relative performance) and the comparison is limited to the companies that are within those parameters* (see at least column 13, lines 10-25).

With regard to Claims 12, 34, 46, 58, and 73, Beck teaches *wherein the data of a company making an inquiry is removable from the market data* (job families, categories, and levels of responsibility have been identified) (see at least column 2, lines 23-32).

With regard to Claims 13 and 59, Beck teaches *wherein the recommended merit increase is based on the group consisting of a general rate of market increase, a performance level, a salary, and combinations thereof* (to compute and recommend appropriate salary increases) (see at least column 13, lines 26-40).

With regard to Claims 14 and 60, Beck teaches *wherein the general rate of market (market rates) increase is based on what the company believes will be its merit increase budget* (see at least column 1, lines 45-60).

With regard to Claims 15 and 61, Beck teaches *wherein the level of performance is selected from the group consisting of outstanding, very good, satisfactory, sometimes acceptable, and poor* (performance rating) (see at least column 13, lines 26-40).

With regard to Claims 16 and 62, Beck teaches *wherein the general distribution of salaries in the company is selected from the group consisting of: positive distribution, normal distribution, and negative distribution* (means, medians, percentiles) (see at least column 14, lines 21-25).

With regard to Claims 17 and 74, Beck teaches *wherein the step of displaying the market data further comprises displaying the data of the company that is using the system, displaying the market averages, displaying the number of participants that provided data for the particular element, and displaying the proportion of company ratios with respect to the market averages* (see at least column 13, lines 10-60 and Fig.'s 4 through 5B).

With regard to Claim 18, Beck teaches *wherein the step of displaying the number of participants that provided data for the particular element further includes displaying the number of incumbents affected by that element* (see at least column 13, lines 10-60 and Fig.'s 4 through 5B).

With regard to Claims 19 and 75, Beck teaches *wherein the graphical display is selected from the group consisting of: benefit analyses, monthly salary quartile graphs (quartile), total annual remuneration quartile graphs, company versus market (graphical) (employee or group, market value), and company versus market (tabular)* (see at least column 13, lines 10-66 and Fig.'s 4 through 5B).

With regard to Claims 20 and 76, Beck teaches *wherein the graphical display of company versus market (graphical) displays two linear regression lines (statistical regression step 37), one for the company and one for the market* (see at least column 7, lines 6-60).

With regard to Claims 21 and 77, Beck teaches *wherein the graphical display of company versus market (tabular) displays two regression tables, one for the company and one for the market (statistical regression step 37), one for the company and one for the market* (see at least column 7, lines 6-60).

Conclusion

10. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Vivona (U.S. 5,960,407) discloses an automated market price analysis system.
 - von Kaenel et al. (U.S. 7,107,285) discloses a method, system, and program for an improved enterprise spatial system that includes graphical and tabular linear regressive modeling in graphical format.
 - Organization for Economic Co-Operation and Development, "Measuring Productivity", OECD Manual, OECD 2001, discloses a manual for the computerized measuring productivity within statistical offices and government agencies including labor compensation and capital utilization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./
Examiner, Art Unit 3623

26 September 2008
Thomas Mansfield

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3623